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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/087,043   | 02/28/2002  | Michelle D. Fabian   | SP02-038                    | 6488             |
| 22928  | 7590        | 04/30/2004           | EXAMINER                    |                  |
| CORNING INCORPORATED<br>SP-TI-3-1<br>CORNING, NY 14831 |             |                      | WYROZEBSKI LEE, KATARZYNA I |                  |
|  |             | ART UNIT             | PAPER NUMBER                |                  |
|  |             | 1714                 |                             |                  |
| DATE MAILED: 04/30/2004                                |             |                      |                             |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                  |  |
|------------------------------|--------------------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.                      | Applicant(s)     |  |
|                              | 10/087,043                           | FABIAN ET AL.    |  |
|                              | Examiner<br>Katarzyna Wyrozebski Lee | Art Unit<br>1714 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 February 2004.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 14-16 is/are allowed.  
 6) Claim(s) 1 is/are rejected.  
 7) Claim(s) 12-13 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

In view of the applicant's amendment mailed on 2/20/2004 the rejections over the prior art of NISHIMURA and HAMANAKA are hereby withdrawn. Any arguments regarding NISHIMURA, JOHNSON and HAMANAKA are considered moot due to discontinuation of these references against present claims and will not be addressed. Withdrawn prior art does not teach particulate sealant.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1 is rejected under 35 U.S.C. 102(a) as being anticipated by BEALL (US 6,300,266)

The prior art of BEALL discloses composition for honeycomb, which traps all the harmful gasses from the exhausts of the vehicles. The honeycomb composition comprises cordierite and binder system in an amount of 2-10 parts by weight. Preferred binder is polyalphaolefin. Surfactant is utilized in amount of 0.2-2 pbw, cellulose polymer is utilized in amount of 2.5-5 pbw and water is amount of 8-25 pbw (col. 5, lines 1-5). The cordierite is

formed upon firing raw components, which include silica, talc, alumina and/or aluminum hydroxide. The raw components comprises 11-17 % MgO, 33-41 % Al<sub>2</sub>O<sub>3</sub> and 46-53 % of SiO<sub>2</sub> (col. 3, lines 55-60).

In the light of the above disclosure the prior art of BEALL anticipates requirements of claims rejected above.

3. In the reply to the first office action on the merits the applicants argued that the prior art of BEAL does not disclose a particulate sealing material for forming plugs in honeycomb.

With respect to the above argument the examiner disagrees. Limitation of “for forming plugs in selected cells of honeycomb” is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The prior art of BEAL teaches sealant therefore the composition of BEAL is viewed as capable of performing the tasks depicted in the claims of the present invention.

BEAL also teaches that the mixture is dry mixed (examples 1-2, col. 6) and that the ceramic components are in form of a powder (col. 5, lines 6-10). Therefore the composition is particulate. The fact that the prior art of BEAL discloses extrusion process does not change the fact that before the extrusion it is in particulate form.

***Allowable Subject Matter***

4. Claims 2-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of BEAL discloses polymers that are cellulotic polymer. The polymer of BEAL is also utilized in much smaller amounts, therefore the defendant claims are objected to.

5. Claims 14-16 are allowed. The prior art of BEAL does not teach use binder consisting essentially of low melting wax, a thermoplastic polymer and dispersant.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski  
Art Unit 1714  
April 28, 2004

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1500

